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OFFICE OF PETITIONS

In re Application of Hull et al.	:	
Application No. 09/532,412	:	Decision on Petition
Filing Date: March 22, 2000	:	
Attorney Docket No. 74451P115	:	

This is a decision on the petition under 37 CFR 1.181, filed January 11, 2008, to withdraw the holding of abandonment.

The petition is **granted**.

Facts:

A Notice of Appeal was filed July 27, 2005.

An Appeal Brief was filed December 27, 2005.

An Examiner's Answer was mailed March 9, 2006. The Examiner's Answer was not signed by the examiner.

Petitioner filed a Reply Brief on May 9, 2006.

On July 26, 2006, the examiner mailed petitioner communication stating,

The reply brief filed 05/09/2006 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

On November 16, 2006, the Board of Patent Appeals and Interferences issued an "Order Returning Undocketed Appeal to Examiner." The order informed the examiner the Examiner's Answer was deficient because it was not signed by the examiner.

On January 16, 2007, the Office mailed a Supplemental Examiner's Answer that was identical to the prior Examiner's Answer except for the signature page.

On March 16, 2007, petitioner filed a Supplemental Reply Brief identical to the Reply Brief previously filed May 9, 2006. Although the examiner had accepted the prior Reply Brief, the examiner determined the Supplemental Reply Brief failed to comply with the requirements of 41.37.

Per 37 CFR 41.37(d), the examiner was required to notify appellant of the reasons for non-compliance and give appellant a time period within which to file an amended brief.

The Examiner mailed a Notification of Non-Compliant Appeal Brief on March 16, 2007. The Notification included the following language, with emphasis added,

(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; **and/or** (b) the brief fails to (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, **and/or** (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

In the section titled, "Other (including any explanation in support of the above items)," the examiner referenced the objection to the brief noted above and stated,

IN SECTION V Summary of the Claimed Subject Matter: The brief does identify each independent claim involved in the appeal but does not map independent claim(s) (1,9,17,25,29,33, and 37) to the specification by page and line number.

As discussed in MPEP 1205.03, petitioner was not required to submit a complete new, amended brief in response to the Notification of Non-Compliant Appeal Brief. Instead, petitioner could simply provide a corrected Summary of the Claimed Subject Matter section.

A revised Summary of the Claimed Subject Matter section was filed April 5, 2007. Although the new section mapped the independent claims to the specification by page number, the section did not map the independent claims by line number for each page.

The examiner mailed a Notification of Non-Compliant Appeal Brief on July 24, 2007. The Notification indicated,

(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; **and/or** (b) the brief fails to (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, **and/or** (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to

the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

The Notification did not provide any explanation as to exactly how the brief failed to comply with the language quoted above.

Petitioner spoke with Everett Williams in the Technology Center in an attempt to understand exactly why the brief remained defective. Petitioner states Williams indicated the brief was still defective because "the previous response only contained page mapping without the line number mapping."

Petitioner submitted a new, revised Summary of the Claimed Subject Matter section on August 24, 2007.

On November 28, 2007, the Office issued a communication stating the appeal was dismissed because "[t]he brief is not in compliance with 37 C.F.R. § 41.37(c)." The communication also stated the application is abandoned since the appeal has been dismissed and no claims stand allowed.

Pursuant to an inquiry by the Office of Petitions, the examiner has indicated the brief remained defective after August 24, 2007, because, even though the brief contained separate sections including arguments with respect to dependent claims 2-5, 10, 11-13, and 18-21, the limitations of the dependent claims were never pointed out in the Summary of the Claimed Subject Matter section.

Discussion:

Per 37 CFR 41.37(d), when a brief is defective, the Office *will* (not may) notify appellant of the reasons for non-compliance and set a time period within which to file an amended brief.

In the instant situation, the Office must determine if the Notifications of Non-Compliant Appeal Brief satisfied the requirement for the Office to notify appellant of the reasons the brief is non-compliant.

Both Notifications indicated,

(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; **and/or** (b) the brief fails to (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, **and/or** (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Language in the MPEP strongly implies the language quoted above, without more, is not sufficient to notify an appellant of the reasons a brief is non-compliant. The MPEP suggests an examiner use the following form paragraph, with emphasis added, when a brief contains a defect in the Summary of Claimed Subject Matter:

The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; and/or does not identify the structure, material, or acts described in the specification as corresponding to each claimed function for every means plus function and step plus function for each independent claim involved in the appeal and for each dependent claim argued separately by reference to the specification by page and line number, and to the drawing, if any, by reference characters, as required by 37 CFR 41.37(c)(1)(v).[1]

Examiner Note

1. In bracket 1, insert an indication of the missing explanation.

The form paragraph quoted above appears to recognize a need for an examiner to include additional language in order to properly notify an appellant of the reason the Summary of Claimed Subject Matter section is non-compliant.

Even if the broad language in the Notices mailed by the examiner, without more, would normally be sufficient to notify an appellant of the reasons the brief is non-compliant, the language is insufficient in the instant situation as a result of language contained in the first Notice. As previously discussed, the Notice mailed March 16, 2007, included a section titled, "Other (including any explanation in support of the above items)." The section referenced the broad objection to the brief previously discussed and stated,

IN SECTION V Summary of the Claimed Subject Matter: The brief does identify each independent claim involved in the appeal but does not map independent claim(s) (1,9,17,25,29,33, and 37) to the specification by page and line number.

A reasonable person could certainly interpret the explanatory language to be an indication of all the reasons the Summary of the Claimed Subject Matter section was defective.

Based on all the facts in the record, the Office concludes petitioner was not properly notified of all the reasons the brief was non-compliant. Therefore, the appeal should not have been dismissed and the application should not have been held abandoned.

Although the petition is granted, the Summary of the Claimed Subject Matter section remains defective. A Notice will be issued requiring the submission of a corrected Summary of the Claimed Subject Matter section.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Technology Center Art Unit 2174 will be informed of the instant decision and the examiner will issue a new, Notice of Non-Compliant Appeal Brief explicitly referencing each defect in the Summary of the Claimed Subject Matter. The time period for responding to the new Notice will be set to run from the mailing date of the new Notice.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Charles Steven Brantley', with a stylized, cursive script.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions